Case No. F6145(C)

REMARKS

Applicant wishes to thank the Examiner for reviewing the present patent application. Applicant submits that all amendments are supported by the specification as originally filed (e.g., at page 7) and no new matter has been added.

I. Rejection Under 35 USC §102(b)

The Examiner has rejected claims 1, 2, 4-6, 8 and 9 under 35 USC §102(b) as being anticipated by Cirigliano et al., U.S. Patent No. 6,120,825 (hereinafter '825). In the rejection, the Examiner mentions, in summary, that the '825 reference discloses a process wherein tea extract is heated and stored and later mixed with water to prepare a beverage on demand. The Examiner further mentions that use of 0.1% extract in a beverage should be known and that tea beverages are inherently translucent and free of visible particles. In view of the above, the Examiner believes that the novelty rejection is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As set forth in the present invention, as amended, independent claim 1 is directed to a method for making a beverage comprising the steps of

(a) heating a beverage extract within a beverage brewing machine to a temperature from about 75°C to about 90°C by contacting the beverage extract with a heating means placed within the beverage extract to produce a heated beverage extract; and

(b) mixing the heated beverage extract with a heated solvent to produce a beverage on demand

wherein the heating means is heated with electrical current, or the heated solvent, or both.

The method of claim 1 is further defined by the dependent claims, which claim, among other things, that the beverage extract is a tea extract, that the heated solvent is water, that the beverage comprises less than 45% by weight heated solvent, that no visible particles are present within the beverage and that the beverage is translucent, and that the beverage comprises at least about 0.1% by weight extract. Newly filed claims 22 and 23 further define the invention by characterizing the heating means as one comprising a metal rod or pipe and by characterizing the beverage brewing machine as a machine for dispensing tea.

In contrast, the '825 reference describes a method for storing, handling and dispensing tea wherein an extract is prepared by steeping hot water over loose tea present within a filter and disposed in a brew cone. Extract is combined with water to form a drinkable tea beverage. Nothing in the '825 reference even remotely discloses a method for making a beverage whereby a beverage extract within a beverage brewing machine is heated to a temperature from about 75°C to about 90°C by contacting the beverage extract with a heating means placed within the beverage extract to produce a heated beverage extract and mixing the heated beverage extract with a heated solvent to produce a beverage on demand wherein the heating means is heated with electrical current or the heated solvent or both. As can be seen in Figure 2 of the '825 reference, extract within storage tank 18 is fed to a dispensing valve 26 via delivery line 28. In the current invention, extract is within the beverage brewing machine and heated within the same via the step of contacting the beverage with a heating means placed within the beverage extract.

In view of the above, it is clear that all the important and critical limitations set forth in the presently claimed invention, as now amended, are not set forth in the '825 reference. Therefore, the rejection made under 35 USC §102(b) is improper and should be withdrawn.

II. Rejection Under 35 USC §103

The Examiner has rejected claims 1 and 4-9 under 35 USC §103 as being unpatentably over Cornelius, U.S. Patent No. 3,532,505 (hereinafter '505) taken alone or with Kappenberg, U.S. Patent No. 2,204,896 (hereinafter '896).

In the rejection, the Examiner mentions, in summary, that the '505 reference discloses a method for making a beverage by heating an extract within a beverage brewing machine whereby the heated beverage extract is mixed with solvent to produce a beverage on demand. The Examiner admits that the '505 reference is silent with respect to temperature, but believes that the temperature limitations of the presently claimed invention are within the purview of the skilled artisan and in view of the '896 reference. In view of the above, the Examiner believes that the obviousness rejection is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention is directed to a specific method for making a beverage that comprises the steps of heating a beverage extract within a beverage brewing machine to a temperature from about 75°C to about 90°C by contacting the beverage extract with a heating means placed within the beverage extract to produce a heated beverage extract and mixing the heated beverage extract with a heated solvent to produce a beverage on demand whereby the heating means is heated with electrical current, or the heated solvent, or both. The invention of claim 1 is further defined by the dependent claims which claim, among other things, that the heated solvent is water, the amount of heated solvent used, that the beverage is translucent and does not comprise visible particles of extract, the amount of extract, that the heating means comprises a metal rod or pipe, and that the beverage brewing machine is a machine for dispensing tea. In contrast, the '505 reference is merely directed to

the supply of liquid coffee to consumers. Figure 1 of the '505 reference shows water added to a coffee extractor which is subsequently sent to a carbonater and then to a storage tank. Figure 2, does not, even remotely, show any beverage extract being heated with a heating means, and particularly, with a heating means that is either heated with an electrical current or by heated solvent. The '896 reference does not cure any of the deficiencies of the '505 reference since it is merely directed to the addition of glycerine to a coffee extract wherein the same is heated to improve flavor characteristics and increase the resistance to rancidity of the extract (all of which does not occur in a beverage brewing machine as required in the presently claimed invention). Since none of the limitations of the invention, as now claimed, are even remotely found in the '505 reference either alone or in combination with the '896 reference, it is clear that a *prima facie* case of obviousness has not been established and the obviousness rejection should be withdrawn and rendered moot.

III. Rejection Under 35 USC §103

The Examiner has rejected claim 8 under 35 USC §103 as being unpatentable over the Cornelius reference and/or the Kappenberg reference further in view of JP 4-45745 (hereinafter '745) or Weisberg et al, U.S. Patent No. 2,338,608 (hereinafter '608). In the rejection, the Examiner mentions that if the Cornelius reference (the '505 reference) does not produce a process wherein the beverage product is translucent and free of visible particles then the '745 reference should be relied on for teaching the production of clear coffee extract by adding an enzyme. Moreover, the Examiner relies on the '608 reference for mentioning clear coffee extract that is sediment free. In view of this, the Examiner believes that the obviousness rejection to claim 8 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention is directed to a process for making a beverage product wherein beverage extract is heated within a beverage brewing machine by contacting the beverage extract with a heating means placed within the beverage extract. Claim 8 further defines the invention such that the beverage that is produced is translucent and free of visible particles. Claim 8 depends from claim 1, and therefore, must be read with the limitations of claim 1. Since the '745 abstract is merely directed to a coffee extract having enzymes added thereto to prevent cloud prevention and the '608 reference is merely directed to a process for preparing coffee extract comprising the steps of leaching in a continuous manner separate portions of freshly roasted ground coffee, none of the deficiencies of the primary reference are cured. Nothing in the '745 reference or the '608 reference even remotely suggests a method for making a beverage comprising the steps of heating a beverage extract by contacting the beverage extract with a heating means placed within the same and within a beverage brewing machine. In view of this, it is clear that all of the important and critical limitations set forth in the presently claimed invention, as now amended, are not even remotely disclosed in the references relied on by the Examiner. In view of this, it is respectfully requested that the obviousness rejection be withdrawn and rendered moot.

IV. Rejection Under 35 USC §103

The Examiner has rejected claim 7 under 35 USC §103 as being unpatentable over Cirigliano et al., U.S. Patent No. 6,120,825 (hereinafter '825) as being applied in paragraph 1. In the rejection, the Examiner mentions, that the '825 reference is silent with respect to how much heated solvent is used to make a beverage. Nevertheless, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to arrive at a solvent amount or dilution amount. Thus, the Examiner believes that the rejection to claim 7 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

Dependent claim 7 is dependent on independent claim 1 which has been amended to further define the present invention. As already made of record, the '825 reference does not, even remotely, describe a method wherein a beverage is made by heating a beverage extract within a beverage brewing machine by contacting the beverage extract with a heating means placed within the beverage extract to produce a heated beverage extract and mixing the heated beverage extract with a heated solvent to produce a beverage on demand wherein the heating means is heated with electrical current or the heated solvent or both. Since none of the important and critical limitations set forth in independent claim 1 in combination with claim 7 are even remotely found in the '825 reference, it is respectfully requested that the obviousness rejection be withdrawn and rendered moot.

V. Rejection Under 35 USC §103

The Examiner has rejected claim 8 as being unpatentable over Cirigliano et al., U.S. Patent No. 6,120,825 (hereinafter '825) taken alone with either one of Tse, U.S. Patent No. 4,52,776 (hereinafter '776) or Lindsey, U.S. Patent No. 2,559,194 (hereinafter '194). In the rejection, the Examiner mentions, in summary, that if the '825 reference does not provide a process where the product is translucent and does not comprise visible particles of extract, the '776 reference is relied on for filtering tea to make tea beverages clear and free of precipitate and the '194 reference is relied on for disclosing a method for preparing tea concentrate that is clear and free of turbidity. In view of this, the Examiner believes that the obviousness rejection is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

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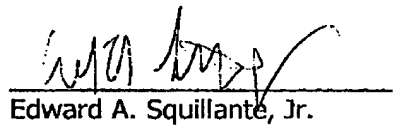
As already made of record, the '825 reference does not describe, even remotely, a method for making a beverage comprising the steps of heating a beverage extract within a beverage brewing machine by contacting the beverage extract with a heating means placed within the beverage extract. Again, the '825 reference is directed to making an extract by steeping tea leaves within a filter with hot water. Since claim 8 is dependent from claim 1 and the '776 and '194 references merely disclose tea with enhanced natural color and tea syrup concentrates that may be stored without deterioration, respectively, it is clear that a *prima facie* case of obviousness has not been established. In view of this, Applicant respectfully requests that the obviousness rejection to claim 8 be withdrawn and rendered moot.

Based on the above, Applicant submits that all pending claims of record are now in condition for allowance. Reconsideration and favorable action are earnestly solicited.

In the event the Examiner has any questions concerning the present patent application, he is kindly invited to contact the undersigned at his earliest convenience.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to:

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In re application of: John William TOBIN
Serial No.: 10/027,848
Filed: December 20, 2001
For: Beverage Brewing System and Method for Brewing a Beverage

Group: 1761
Examiner: Anthony Weier
Englewood Cliffs, New Jersey 07632

Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an amendment in the above-identified application.
[ ] No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED

	(2) * Claims Remaining After Amendment		(4)** Highest No. Previously Paid For	(5) Present Extra	(6) Rate	(7) Additional Fee
Total Claims	11	Minus	20		$ 50.00	—
Independent Claims	1	Minus	3		$ 200.00	—
Multiple Claims					$ 360.00	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					$	0.00

*If the entry in Column (2) is less than the entry in Column (4), write "0" in Column (5).
**If the "Highest No. Previously Paid For" is less than "20," write "20" in this space.

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[X] The Commissioner is hereby authorized to charge any additional fees, which may be required to our Deposit Account No. 12-1155, including all required fees under
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